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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,748	12/22/2000	Michael D. Powell	20143-000110US	4713

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,748

Applicant(s)

POWELL, MICHAEL D.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 3, 12, 17 and 22 are objected to because of the following informalities: the phrase "corresponding description" should be "the corresponding detailed description". Appropriate correction is required.
2. Claim 13 is objected to because of the following informalities: to avoid duplication with claim 4, claim 13 should depend on claim 9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 15 recite the limitation "the user's unmet need(s) or unsolved problem(s)" in line 4 of claim 1 and in line 6 of claim 15. There is insufficient antecedent basis for this limitation in the claims.

Claims 9 and 19 recite the limitation "the originator's proposal" in line 4 of claim 9 and in line 6 of claim 19. There is insufficient antecedent basis for this limitation in the claims.

Claims 10 and 20 recite the limitation "the user's unmet need or unsolved problem" in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claims.

Claims 2-8, 10-14, 16-18 and 20-25 are rejected for incorporating the errors of their respective base claims by dependency.

Claim 9 recites "providing the originator with access ..." in line 11. Should it be "providing the user with access"?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U. S. Patent 5,862,223 in view of Shear, U. S. Patent 5,050,213.

As to claim 1, Walker teach a method of using a computer to conduct a transaction between a user and an originator comprising (abstract):

- a) Inputting into the computer a basic description and a corresponding detailed description of the user's unmet need or unsolved problem (column 16 line 62 – column 17 line 35 and Figs. 1-2, 6);
- b) Permitting the originator to access the descriptions of the user's unmet needs or unsolved problems (column 38 lines 32-50 and Fig. 32);
- c) Providing the originator an option to answer the detailed description by agreeing to an online license agreement (column 38 lines 61-65 and Figs. 32-33);

- d) Inputting into the computer an indication of agreement by the originator to the online agreement (column 38 lines 61-65);
- e) Providing the originator with access via the computer to the corresponding detailed description (column 38 lines 59-65 and Figs. 33).

Walker does not specifically teach permitting the originator to access only the basic description of the user's unmet needs or unsolved problem before the originator agrees the online license agreement. However, Shear teaches limiting access to various portions of a database only to a person possessing the proper level of security code (column 8 lines 10-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Walker to include different levels of access to the user's unmet needs or unsolved problems because it would allow the system to better protect the user's privacy from the originator before the originator agrees the online license agreement.

As to claim 2, Walker teaches the online license agreement is a limited duration, exclusive license (column 17 line 16-35 and column 38 lines 40-41).

As to claim 3, Walker modified by Shear as discussed above does not specifically teach after the originator has indicated agreement to the online license agreement, disallowing other potential originators from access the basic description and corresponding detailed description for the duration of the license agreement. It would have been obvious to one of ordinary skill in the art to allow the method of Walker modified by Shear to include the feature of preventing other potential originators to answer/work the same problems with the user when the user and other originator

already had a validated agreement because it would prevent the user to pay double or more fees to multiple originators.

As to claim 4, Walker teaches the corresponding detailed description is stored in the computer in encrypted form (Figs. 25-27).

As to claim 5, Walker modified by Shear teaches providing the originator with an access key to decrypt the corresponding detailed description after agreeing the license agreement (Walker: column 15 lines 10-14; Shear: column 8 lines 10-16).

As to claim 6, Walker teaches inputting into the computer a proposal by the originator to address the user's unmet need or unsolved problem (Figs. 33-34).

As to claim 7, Walker teaches the license agreement is nonexclusive (Figs. 9, 32).

As to claim 8, Walker teaches the originator access the corresponding detailed description using an Internet browser (abstract and column 43 lines 1-6).

As to claim 9, Walker teach a method of using a computer to conduct a transaction between an originator and a user comprising (abstract):

- a) Inputting into the computer a basic description and a corresponding detailed description the originator's proposal (Fig. 9);
- b) Permitting the user to access the descriptions of the originator's proposal (Fig. 9);
- c) Providing the user an option to accept the detailed description by agreeing to an online license agreement (Figs. 9, 34);

- d) Inputting into the computer an indication of agreement by the user to the online agreement (Figs. 9, 34);
- e) Providing the originator with access via the computer to the corresponding detailed description (Figs. 9, 33-34).

Walker does not specifically teach permitting the user to access only the basic description of the originator's proposal before the user agrees the online license agreement. However, Shear teaches limiting access to various portions of a database only to a person possessing the proper level of security code (column 8 lines 10-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Walker to include different levels of access to the originator's proposal because it would allow the system to better protect the originator's proposal information from the user before the user agrees the online license agreement.

As to claim 10, Walker teaches the originator's proposal is in response to the user's unmet need or unsolved problem inputted and accessed using the computer (Fig. 9).

Claims 11 and 13 are rejected for the similar reasons as claims 2 and 4.

As to claim 12, Walker modified by Shear as discussed above does not specifically teach after the user has indicated agreement to the online license agreement, disallowing other potential users from access the basic description and corresponding detailed description for the duration of the license agreement. It would have been obvious to one of ordinary skill in the art to allow the method of Walker modified by Shear to include the feature of preventing other potential user to access the

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originator's proposal when the user and the originator already had a validated agreement because it would protect the value of the originator's work by preventing other users to obtain the proposal for free.

As to claim 14, Walker modified by Shear teaches providing the user with an access key to decrypt the corresponding detailed description after agreeing the license agreement (Walker: column 15 lines 10-14; Shear: column 8 lines 10-16).

Claims 15-24 are rejected for the similar reasons as claims 1-5 and 8-13.

As to claim 25, Walker teaches the storage device is a computer fixed disk device (Fig. 4).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Olsen et al. (U. S. Patent 5,905,860) discloses a license service provider generates an executable entity based on the request parameters, which searches the database and, if the appropriate units are available, assembles a license.

Rabne et al. (U. S. Patent 6,006,332) discloses an unsecure client is provided with a launch pad program which is capable of communicating with a secure Rights Management (RM) server. The launch pad program provides an indicator to a public browser, used by the unsecured client, which acknowledges when a rights management controlled object is detected.

Carter et al. (U. S. Patent 6,219,652) discloses an on-line vendor receives a digital certificate that includes a public key associated with a consumer, and a digital signature of the consumer.

Anand et al. (EP 0 813 133 A2) discloses a scheme for downloading signed content onto a machine by a delivery mechanism is described. While there are no restrictions on the nature of the contents, the signature on the content describes the security credentials of the creator, the resource requirements, and licensing information.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

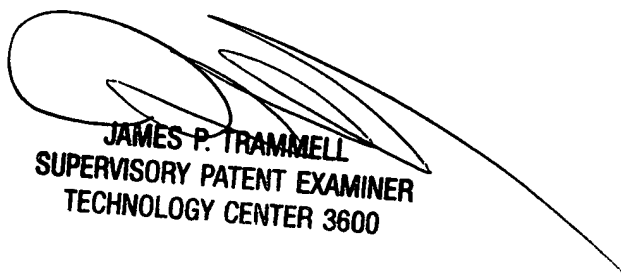
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687 (Official Communications; including After Final
Communications labeled "BOX AF")
(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
February 28, 2003


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